INDEX

OPINIONS BELOW 1

QUESTION PRESENTED 2

STATUTE INVOLVED 3

STATEMENT 3

I. The Nature of the Litigation and the Identity of the Parties 3

II. The Difficult Situation in the Industry Prior to the Scoggin Invention 4

III. The Scoggin Invention Mastered the Problem Which Calmar Continued to Be Unable to Solve 8

IV. The Invention of the Scoggin Patent 11

V. The Decisions Below 16

SUMMARY OF ARGUMENT 19

ARGUMENT 21

I. The Courts Below Correctly Held That the Invention Met the Requirements for Patentability Established by Congress 21

A. The Patent in Question Covered a Novel Combination of Known Elements 22

B. The Shipper-Sprayer in Issue Clearly Had Significant Commercial Utility 29

C. Respondent's Invention Was Not Obvious to a Person Having Ordinary Skill in the Art .. 31

II. The Decisions Below Do Not Substitute "Commercial Success for Invention" 35

III. The Decision of the Court Below Did Not Countenance "A Debasement of the Constitutional Standard of Invention" 38

CONCLUSION 44

APPENDIX A1

Citations

CASES

Bates v. *Coe*, 98 U.S. 31 (1878) 24

Bros. Inc. v. *Browning Mfg. Co.*, 317 F.2d 413 (8th Cir. 1963) 41

Caldwell v. *Kirk Mfg. Co.*, 269 F.2d 506 (8th Cir. 1959) 41

Collins v. *Owen*, 310 F.2d 884 (8th Cir. 1962) 41

Cuno Engineering Corp. v. *Automatic Devices Corp.*, 314 U.S. 84 (1941) 17, 26, 28, 31, 39, 42

Diamond Rubber Co. v. *Consolidated Rubber Tire Co.*, 220 U.S. 428 (1911) 24, 34

Expanded Metal Co. v. *Bradford*, 214 U.S. 366 (1909) ..34, 35

Ezee Stone Cutter Mfg. Co. v. *Southwest Industrial Products*, 262 F.2d 183 (8th Cir. 1958) 36, 42

Forestek Plating & Mfg. Co. v. *Knapp-Monarch Co.*, 106 F.2d 554 (6th Cir. 1939) 36

Goodyear Tire & Rubber Co., Inc. v. *Ray-O-Vac. Co.*, 321 U.S. 275 (1944) 34, 35

Great Atlantic & Pacific Tea Co. v. *Supermarket Equipment Corp.*, 340 U.S. 147 (1950) 17, 26, 27, 28, 29, 42

Hailes v. *Van Wormer*, 87 U.S. (20 Wall.) 353 (1873) 24

H. D. Hudson Mfg. Co. v. *Standard Oil Co.*, 60 F.2d 377 (8th Cir. 1932) 42

Hildreth v. *Mastoras*, 257 U.S. 27 (1921) 30

Hotchkiss v. *Greenwood*, 52 U.S. (11 How.) 248 (1850) 31

John Blue Co. v. *Dempster Mill Mfg. Co.*, 275 F.2d 668 (8th Cir. 1960) 41, 42

John Deere Co. of Kansas City v. *Graham*, 333 F.2d 529 (8th Cir. 1964), *cert. granted*, No. 11, Oct. Term 1965 41

Johnson Fare Box Co. v. *National Rejectors, Inc.*, 269 F.2d 348 (8th Cir. 1959) 41

Krementz v. *S. Cottle Co.*, 148 U.S. 556 (1893) 34

Keystone Mfg. Co. v. *Adams*, 151 U.S. 139 (1894) 24

Lincoln Engineering Co. v. *Stewart-Warner Corp.*, 303 U.S. 545 (1938) 26, 28, 29

Loom Co. v. *Higgins*, 105 U.S. 580 (1881) 24, 34

McGraw-Edison Co. v. *Central Transformer Corp.*, 308 F.2d 70 (8th Cir. 1962) 41

Mergenthaler Linotype Co. v. *Press Publishing Co.*, 57 Fed. 502 (C.C. S.D. N.Y. 1893) 30

Parks v. *Booth*, 102 U.S. 96 (1880) 24

Pearce v. *Mulford*, 102 U.S. 112 (1880) 31, 42

Reiner v. *I. Leon Co.*, 285 F.2d 501 (2d Cir. 1960) 36, 38

Rota-Carb Corp. v. *Frye Mfg. Co.*, 313 F.2d 443 (8th Cir. 1963) 41

Scherr v. *National Bio-Test, Inc.*, 301 F.2d 901 (8th Cir. 1962) 41

Selmix Dispensers, Inc. v. *Multiplex Faucet Co.*, 277 F.2d 884 (8th Cir. 1960) 41

Steffan v. *Weber Heating & Sheet Metal Co.*, 237 F.2d 601 (8th Cir. 1956) 42

Syracuse v. *H. Daust Mfg. Co.*, 280 F.2d 377 (8th Cir. 1960) 41

Telephone Cases, 126 U.S. 1 (1888) 30

Temco Elec. Motor Co. v. *Apco Mfg. Co.*, 275 U.S. 319 (1928) 36

The Barbed Wire Patent, 143 U.S. 275 (1892) 34

Toledo Pressed Steel Co. v. *Standard Parts, Inc.*, 307 U.S. 350 (1939) 26, 29

Tropic-Aire v. *Sears, Roebuck & Co.*, 44 F.2d 580 (8th Cir. 1930) 42

Wm. F. Crome & Co. v. *Vendo Co.*, 299 F.2d 852 (8th Cir. 1962) 42

STATUTES

35 U.S.C. § 101 ..... 2, 3, 16, 19, 21, 27, 29, 39

35 U.S.C. § 102 ..... 2, 3, 16, 19, 21, 27, 39

35 U.S.C. § 103 ..... 2, 3, 17, 19, 21, 27, 31, 32, 35, 39, 42

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1965

No. 37

CALMAR, INC.,

Petitioner,

vs.

COOK CHEMICAL COMPANY,

Respondent.

No. 43

COLGATE-PALMOLIVE COMPANY,

Petitioner,

vs.

COOK CHEMICAL COMPANY,

Respondent.

ON WRITS OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT

BRIEF FOR RESPONDENT

OPINIONS BELOW

The opinion of the Court of Appeals is reported at 336 F.2d 110, and appears at R. 555. The opinion of the District Court for the Western District of Missouri is reported at 220 F. Supp. 414, and appears at R. 17.

QUESTION PRESENTED

The patent in issue covers a *shipper-sprayer*, which is a unit capable of being integrated and shipped with a liquid container as a composite package. It combines for the first time in the history of the art (1) a pump-type liquid sprayer; (2) a cover cap that is initially assembled with the sprayer at the time the unit is manufactured, that houses and holds the plunger of the pump depressed for protection against damage and accidental actuation during shipment and handling; (3) a seal established within the cover cap when it is first assembled as a part of the sprayer unit, that prevents leakage to the outside of the container; and (4) a container cap that can be sealed to the container without breaking the seal within the cover cap and that need not be removed by the user before spraying.

The District Court found that the subject matter of the patent was new, useful, and not obvious to a person having ordinary skill in the art and hence met the conditions for patentability prescribed by Sections 101-103 of the Patent Act of 1952. The Court of Appeals affirmed these findings, and in so doing applied the legal standards long required by this Court.

The question presented is whether the court below correctly held that these findings were supported by the record and that the patent was valid.*

---

*Petitioners have not asked this Court to review the holdings below that they infringed the patent. Infringement should therefore be taken as established.

STATUTE INVOLVED

The relevant provisions of the Patent Act of 1952, 35 U.S.C. §§101, 102 and 103 are set forth in the Appendix.

STATEMENT

I. The Nature of the Litigation and the Identity of the Parties.

These cases were instituted by complaints filed in the United States District Court for the Western District of Missouri by Colgate-Palmolive Company (Colgate) and Calmar, Inc. (Calmar) against Cook Chemical Company (Cook), seeking a declaratory judgment that U. S. Patent No. 2,870,943 issued to Baxter I. Scoggin, Jr. on January 27, 1959, and owned by Cook, was invalid and not infringed by plaintiffs. In each action the defendant answered and also counterclaimed seeking a declaration of validity of its patent and a finding of infringement.*

Cook, a small corporation located in Kansas City, Missouri, is primarily engaged in the business of making and selling insecticides and certain other chemical products. Since 1954 Cook has also manufactured plastic sprayers for liquids, having entered this field by internal expansion under circumstances that are described below. In fiscal 1964 Cook's total sales were $7,227,721 and its total current assets amounted to $2,604,802. Calmar is a wholly-owned subsidiary of The Drackett Company (Drackett), which is engaged in the manufacture and sale of a variety

*Against Colgate, Cook also counterclaimed for trademark infringement and for unfair competition, alleging a variety of imitative practices. That counterclaim was severed and awaits trial in the District Court.

of products, including a window cleaner called "WINDEX."* Through Calmar, Drackett manufactures shipper-sprayers, which it uses in its business and which it also sells to other users. Colgate purchased its requirements of shipper-sprayers from Calmar. Colgate is a very large corporation engaged in producing and distributing a variety of products, including an insecticide that it marketed under the trademark "KAN-KIL" in competition with "REAL-KILL" insecticide manufactured and sold by Cook.**

The suits grew out of the competitive struggle in the business of manufacturing and selling insecticides. Until recent years that business was carried on by a substantial number of small companies scattered throughout the country, of which respondent was one (R. 19, 54-55). More recently the industry has undergone structural changes as a result of the entry into the business of large corporations, such as Colgate, which are engaged in diversified activities and operate on a national scale (R. 53).

II. The Difficult Situation in the Industry Prior to the Scoggin Invention.

For many years those engaged in the household insecticide business had been faced with a serious problem of providing shipper-sprayers which could successfully be integrated with the containers in which insec-

---

*In 1964 Drackett's net sales were $58,476,246 and its balance sheet showed total current assets of $17,779,740 (Moody's Industrial Manual, 1965, pp. 1723-1724).

Since the institution of this litigation Drackett has been acquired by Bristol-Myers Company (Moody's Industrials—News, Vol. 37, No. 15, p. 2755, July 9, 1965).

**In 1964 Colgate was 74th in a list of the 500 largest United States Industrial Corporations ranked in terms of sales. See Fortune Magazine, July, 1965, p. 152. In 1964 its gross sales amounted to $806,580,876 and its total current assets to $284,740,891 (Moody's Industrial Manual, 1965, pp. 1608-1610).

ticides were marketed. When Cook entered the household insecticide field in 1945, the customer was subjected to the inconvenience of having to apply the insecticide through the use of tin sprayers, which were not supplied by the seller of the insecticide but had to be purchased separately by the customer from other sources (R. 19, 50-51, 556).

In 1947 Cook commenced furnishing its customers with plastic pump-type sprayers (R. 18, 51, 556), utilizing both cardboard and plastic holders as a means of hanging the sprayers on the side of the bottles (R. 20, 51, 52, 556).* The practice of hanging the sprayer on the side of the container continued unchanged for a period of ten years (R. 556) prior to the first commercialization of the Scoggin invention (R. 152).

Hanging the sprayer on the side of the bottle was replete with shortcomings (R. 20, 52, 53, 556); many separate, expensive and troublesome operations were necessary. After filling, an imperforate container cap had to be applied and sealed on the bottle; the cardboard holder had to be placed on the neck; each sprayer and each holder had to be separately handled; and the dip tube had to be inserted into the small hole of the holder (R. 53).

Sprayer breakage, as admitted by petitioner Calmar (R. 299), even before the package reached the shelves of the retailer, was a handicap which of itself presented a need for the Scoggin invention (R. 60, 151, 152, 315).

---

*It is such attachment of the sprayer to the bottle by a holder which respondent's president (R. 51) and the appellate court (R. 556) referred to as "a sales promotion gimmick," not the patented unit here in issue as petitioners imply (Pet. Br. p. 30). The references to petitioners' brief herein are to the brief filed by petitioner Calmar, unless otherwise specifically indicated. The additional arguments made in the Colgate brief add nothing of substance to the Calmar brief.

From the time the shipping carton was opened and the packages placed on the retail shelves and until they reached the hands of the housewife, avoidance of loss of the sprayer from the holder presented a troublesome task. Rapid and careless handling together with pilferage (R. 299, 315, 323, 332, 333) resulted in the need for a better package. From the time the housewife took the package off the retail shelf and placed it in a shopping basket, until she removed it from the retail store in a shopping bag, constant care had to be exercised to avoid accidental loss and breakage of the sprayer. As distinguished from the more convenient aerosol package (R. 556), before the product could be placed in use the container cap had to be removed, the sprayer inserted into the bottle and the cap on the sprayer attached into proper sealing relationship to the neck of the bottle.

The difficulties and disadvantages involved in attaching the sprayer to the container were so great that Cook, which had no experience in or knowledge of the manufacture of sprayers, urged Calmar to develop a shipper-sprayer that could be installed in the bottles and that would prevent leakage in shipment, that would not be subject to damage in shipment and that would not be vulnerable to pilferage after it reached the retailers' shelves (R. 20, 556, 557). Beginning in 1949 Calmar attempted unsuccessfully to solve the problem and designed a number of devices, as for example, a cellulose cover or hood for application over the top of the sprayer (R. 76), a flat back bottle (R. 336), a plug for the end of the sprayer tube (R. 325, 337), a boot to be placed inside the filled bottle (R. 537, 542), and several other devices such as a cap over the discharge nozzle (R. 337, 338). None of these devices proved satisfactory (R. 322, 325, 333).

In 1954 petitioner Colgate-Palmolive Company diversified beyond its normal line of products and entered the

household insecticide field in competition with respondent, selecting the trademark "KAN-KIL" and selling alongside respondent's product long known by the trademark "REAL-KILL" (R. 19, 53, 556). Colgate limited its packages to aerosol cans for the first few years of its insecticide business but in 1958 expanded to liquid insecticides (R. 19, 54, 556).* The same trademark "KAN-KIL" was used by Colgate when it commenced packaging liquid insecticides in bottles (R. 19); and not only did it select a bottle such as that employed by respondent, but sprayers obtained from the same source were hung on the side of such bottles in the same manner and through the use of the same type of cardboard holder as had become known in the trade by respondent's customers over the previous seven-year period (R. 54, 556). (See photograph in the Appendix hereof showing such Colgate package.)

The convenience of an aerosol sprayer, presenting a ready-to-use package to the housewife, was appreciated by Colgate (R. 556); and after four years of use, it expressed to Calmar its desire for a package similar to an aerosol package for liquid insecticides (R. 542). However, Calmar was not able to furnish Colgate with a satisfactory package, forcing Colgate to adopt the only packaging method then known in the industry, *i.e.*, hanging the sprayer on the side of the bottle, which had been pioneered by Cook.

---

*An aerosol package is a pressurized can which contains a propellant gas in addition to the product. The product in the package is sprayed by the action of the propellant gas when a pushbutton on the top of the package is depressed.

Colgate recognized the fact that Cook had an established market in liquid insecticides which are less costly to the consumer than the aerosols and fill a need for riddance of crawling insects, whereas the more expensive aerosols provide a finer mist and are used primarily to combat flying pests.

III. The Scoggin Invention Mastered the Problem Which Calmar Continued to Be Unable to Solve.

Upon the sale of Calmar to Drackett in 1954 Cook felt impelled to organize a small company, which it called Bakan Plastics, Inc., for the purpose of manufacturing the unpatented sprayers, because of its fear that Drackett would use its own major output of sprayers on "WINDEX". Actual production by Bakan commenced in 1956 (R. 20, 55, 556). Even in 1955, before Cook had finished its preliminary work in connection with its first sprayer, Scoggin began devoting his attention to the possibility of producing a shipper-sprayer capable of being integrated with the bottle (R. 145, 146). His work finally resulted in the invention upon which the Scoggin patent application was filed on March 4, 1957 (R. 21, 510-512).

The shipper-sprayer invention by Scoggin includes, in brief description, a plastic liquid sprayer installed in a bottle cap with a plastic overcap that screws into plastic threads on a collar mount for the sprayer onto the bottle cap. When the overcap is screwed into these threads the plunger of the sprayer is depressed and protected against breakage. By means of a junction of the shoulder on the inside of the overcap and a rib at the top of the mount for the sprayer a seal is formed above the threads when the overcap is applied and screwed down, thereby preventing leakage of the liquid contents* outside of the overcap. The design of the unit is such that it can be automatically installed in one piece, with the overcap attached and sealed, on the filled bottle. After purchase, the ultimate consumer merely removes and discards the overcap, and is then ready to commence spraying the contents of the container.

---

*Such as, insecticides, window cleaners and many other liquids in chemical, medicinal and other fields.

The Scoggin invention came on the market in August, 1957 (R. 152). In less than a year and a half, during the remainder of 1957 and through 1958, Cook's original Bakan-2 unit was sold in quantities of at least 15 million (R. 153, 158). Sales of such original model continued to as late as 1959 and perhaps into 1960 (R. 153). A single customer used one million (R. 158). The production by respondent ran from 100,000 to 110,000 units per day. This production was in the face of heavy competition from Calmar, as it voluntarily admitted in open court, to the extent of its having manufactured many *millions* of the accused structure (R. 66).

Following the acquisition of Calmar by Drackett in 1954, Calmar continued to expend time and money in an endeavor to develop a successful shipper-sprayer (R. 557). Its efforts were directed, in part, to the provision of a boot (R. 537, 561) which proved to be totally unsatisfactory. Calmar also attempted tenaciously to develop a so-called "sealed-in" sprayer (the S-25-LP) designed to be inserted into the container and to have its plunger locked by a bayonet slot-lug. A seal within the sprayer was supposed to have prevented leakage to the outside of the container. This device had been earlier submitted to respondent by Calmar and rejected because it leaked (R. 55, 56).

The S-25-LP was presented by Calmar to its customers as a shipper-sprayer and one of such customers, S. C. Johnson & Son, Inc., tried to solve Calmar's difficulties by a hood to contain the leakage past the seal (R. 76). On March 13, 1958 it was reported to Calmar that S. C. Johnson & Son, Inc., was still having leakage problems with the S-25-LP, "too serious to gamble with" (R. 539); also, that Johnson had Cook's Bakan unit on test "and cap is not leaking" (R. 538, 539). The S-25-LP sprayer never became successful (R. 75, 301) notwithstanding the vast

source of research and development capital now available from Drackett. Calmar's president admitted that such sprayer continued to plague (R. 77) them with grievous, serious (R. 74) and sad experiences and great difficulties (R. 20, 77, 557).

Calmar became aware of the Scoggin invention in the fall of 1957, soon after it came on the market (R. 78). In December of that year, Colgate rejected Calmar's so-called "leakproof boots" and expressed a preference for a sprayer unit similar to the Scoggin invention (R. 542). In the same month, Calmar employed Douglas F. Corsette, who had been employed by a company that built an automatic assembling machine for assembling sprayers and who held both a Bachelor's and a Master's Degree in engineering, and he was thereafter given an assignment to develop an adequate shipper-sprayer (R. 542, 79-90). The president of Calmar testified that this was done "because we were faced with real problems with our customers, our own products" (R. 306), referring to S. C. Johnson & Son, Inc. and the leaky S-25-LP device which Johnson was using.

In March, 1958, the president of Calmar, referring to the possibility of developing a new leak-proof sprayer, said that it was difficult "to restrain my enthusiasm for this item" and that such a sprayer "is what we need to seize market initiative from our competitors next year." (R. 550.)

On September 9, 1958, a patent application was filed on the infringing shipper-sprayer (R. 529, 561), initially *seeking patent protection on the same basic combination of elements as is found in the claims of the Scoggin patent here in issue* (R. 283). Commercial production commenced prior to January 27, 1959 (R. 261). In 1958 or 1959, S. C. Johnson & Son, Inc. abandoned Calmar's S-25-LP with the

hood and began using the infringing sprayer with its "RAID" insecticide (R. 57, 58). Similarly, Colgate abandoned the practice of hanging the sprayer on the side of the bottle in favor of the infringing sprayer. (See photograph in Appendix.)

The "dead ringer" copying by Calmar, Inc. (R. 563) is recorded clearly and emphatically by the lower courts:

> "Exercising our appellate prerogative in a patent case to interpret the exhibits for ourselves, we are constrained to agree with the trial court's statement that 'Upon close inspection of the devices, it is difficult to see how they could be much more similar and yet have any different fetures'." (R. 562.)

IV. The Invention of the Scoggin Patent

Scoggin Patent No. 2,870,943 in suit (Def. Ex. 10; R. 84) includes a sheet of drawings (R. 510), reproduced on pages 12 and 13 hereof, the resultant package as shown, for example, at R. 513 (Def. Ex. 31), being also illustrated in our appendix. There are two caps, the perforated container cap 14 screwed onto neck 16 of container 12 and cover cap 40 screwed onto collar 18 of sprayer 10.

The pump-type sprayer unit 10 has a spray head 34 secured to the upper end of a plunger 26; a barrel 24, receives a plunger 26 having a dip tube 30 on its lower end for drawing liquid from container 12.

Pump 10 is supported by container cap 14 or, stated another way, cap 14 is attached to pump 10. Barrel 24 passes through a hole in the top of container cap 14. A gasket 38 lies across the upper edge of container neck 16, serving as a seal between container cap 14 and container neck 16. A collar or annular retainer 18 is secured to barrel 24.

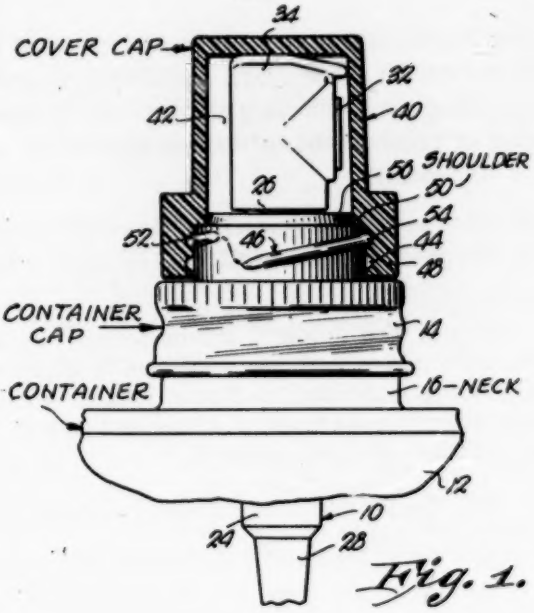
34
COVER CAP
32
42
40
SHOULDER
50
26
50
54
52
46
44
48
CONTAINER CAP
14
CONTAINER
16—NECK
12
10
24
28

Fig. 1.

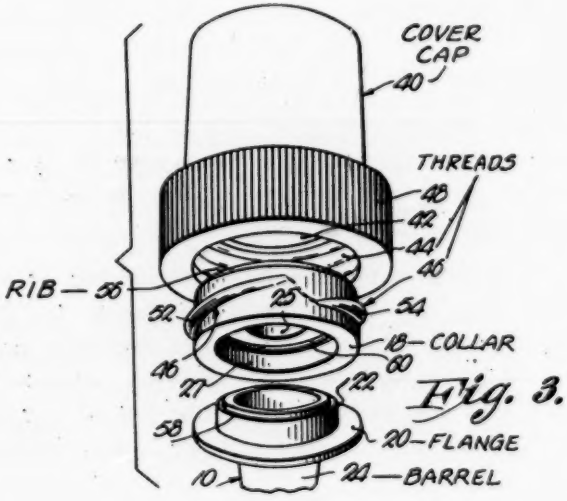
COVER CAP
40
THREADS
42
44
46
RIB — 56
52
25
54
18— COLLAR
46
27
60
22
58
20—FLANGE
10
24—BARREL

Fig. 3.

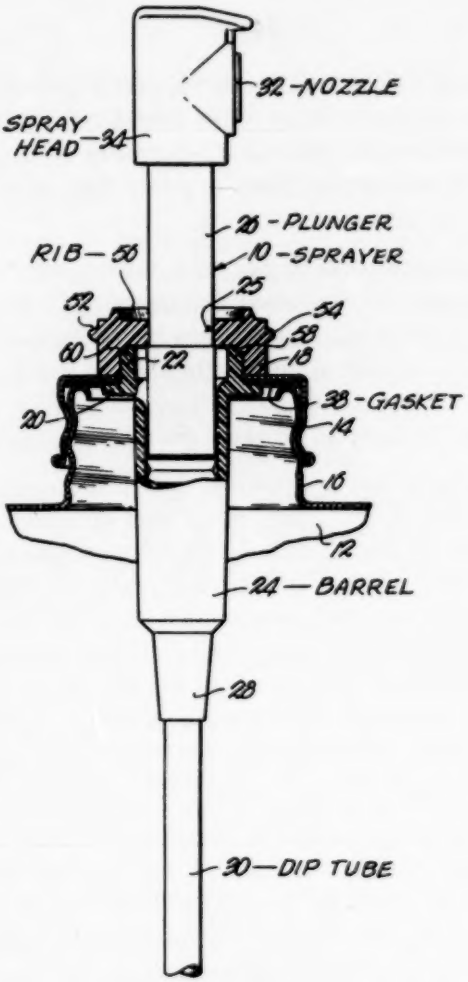

Fig. 2.

INVENTOR.
Baxter I. Scoggin
BY
ATTORNEY

Thus, when cap 14 is on neck 16, pump unit 10 is supported in its upright position, with barrel 24 and dip tube 30 disposed inside container 12. Before cap 14 is screwed onto neck 16 it remains attached to pump unit 10 by virtue of the retaining action of collar 18.

The cup-shaped cover cap or hold-down member 40 not only holds plunger 26 depressed at substantially the innermost end of its path of travel within barrel 24 but houses spray head 34. External screw threads 46 on the outer cylindrical side wall of collar 18 complementally engage internal screw threads 44 in the bore 42 of cover cap 40.

A liquid-tight seal is provided between sprayhead 34 and threads 44 and 46. The sealing part of collar 18 surrounds plunger 26 and is shown as a rib or segment 56 on the upper part of retainer 18 above threads 46. The sealing part of cover cap 40 is a shoulder 50 which is the internal corner between the small diameter part and the large diameter part of bore 42. Shoulder 50 engages the sealing rib 56 and is deformed thereby into sealing engagement therewith as cover cap 40 is screwed down onto collar 18 to depress and enclose spray head 34.

This is the area (between shoulder 50 and rib 56) where petitioners are still asserting that leakage occurred to such extent as to render respondent's unit a commercial failure (Pet. Br. pp. 10, 23, 24, 27). *And it is this particular and exact type of seal 50-56 that petitioners continue to assert is the Scoggin invention* (Pet. Br. pp. 2, 4, 6, 10, 18, 22). *Both assertions are directly contrary to the findings below* (R. 24, 28, 560-562).

The lower edge of cover cap 40 does not engage the top of container cap 14. Thus, there is no sealing against container cap 14 or against any type of gasket overlying container cap 14. Instead, all of the sealing takes place

on collar 18 within cover cap 40, and the tight engagement of shoulder 50 against rib 56 takes place as cover cap 40 is screwed onto collar 18, but without cover cap 40 moving into engagement with container cap 14.

Petitioners contend that Mr. Scoggin represented to the Patent Office that this space or gap (between the two caps) was his "invention". Petitioners claim that upon a representation that such "invention" was not shown by the prior art, the Patent Office issued the patent (Pet. Br. pp. 5, 6, 7). *Again this is all directly contrary to the findings below* (R. 27).

The Court of Appeals accepted the following description, given by respondent's expert witness, as an accurate statement of "the device's novel contribution to the industry" (R. 559):

> "The first commercially successful, inexpensive integrated shipping closure pump unit which permitted automated assembly with a container of household insecticide or similar liquids to produce a practical, ready-to-use package which could be shipped without external leakage and which was so organized that the pump unit with its hold-down cap could be itself assembled and sealed and then later assembled and sealed on the container without breaking the first seal." (R. 279.)

In its advertising anouncements of its new product Cook defined the contribution of the invention in a manner consistent with this testimony. Cook's advertising literature stated that the "sprayer comes completely assembled with a protective plastic cap * * *" and that the product "manufacturer can begin immediately to package his product with

the sealed-in sprayer" (R. 430).* Both the trial court and the Court of Appeals accepted these descriptions of the nature of the invention. In view of these findings and the facts which support them, there is no basis for petitioners' assertion that the Scoggin invention is (a) in the provision of the space or gap, (b) in any special type of seal, (c) in rearrangement or reshuffling of component parts or (d) in any other minute detail as contended by petitioners (Pet. Br. pp. 2-7, 10, 12, 17, 18, 20-23, 26).

V. The Decisions Below

The District Court held that the Scoggin patent was valid. It found that the Scoggin patent met the requirements of novelty and utility set forth in Sections 101 and 102 of the Patent Act (35 U.S.C. §§101, 102). In dealing with these requirements the court, although noting that the invention was composed of known elements, held that the combination of these elements solved the problems of leakage and breakage in the shipment of the products with which the spray pumps were used. It considered the prior art relied upon by petitioners and held that it did not disclose or teach the invention. In dealing with the requirement of utility, the court relied primarily on the fact that the invention solved the problems of leakage and breakage. The court also referred to the commercial success of the Scoggin patent, saying that it was "an element that may be taken into consideration in determining the question of invention, but is not necessarily determinative of the issue." (R. 28.)

---

*Respondent's advertising stated, adjacent to an illustration of the new package:

> "COMPLETELY ASSEMBLED 'IN THE BOTTLE' SPRAYER Super polyethylene cover cap provides a sealed, leak-proof protective cover for the sprayer. Enables manufacturer to ship and merchandise his product with a sprayer in the container. READY TO USE. Eliminates the problem of broken or lost sprayers on dealers' shelves." (R. 431.)

The District Court further held that the patent met the condition for patentability prescribed in Section 103 of the 1952 Patent Act because the subject matter was not obvious at the time the invention was made to a person having ordinary skill in the art. In dealing with this point the Court said:

> "The manufacturers of sprayers had not been able to solve the problem of leakage and breakage in the shipment of the products with which their spray pumps were used. Numerous ideas had been suggested by Calmar, the experiments were made, but none of them solved the problem. These facts and circumstances certainly must lead us to seriously doubt that it was so simple a mechanical problem as it seems now that it has been solved. However, simplicity and obviousness after the event do not negative invention. *Goodyear Co.* v. *Ray-O-Vac Co.*, 321 U.S. 275 and cases cited in note 4, p. 279.
>
> "Now that it has been solved, one trained in mechanics and in the art might say, 'Well, that was a very simple problem and should easily have been solved', but the fact that many people were thinking about and working on it, and were unable to come up with the answer, raises it above the principle of mere simplicity. Hindsight is generally 20-20." (R. 25.)

The Court of Appeals for the Eighth Circuit affirmed the judgment of the District Court. The court stated that it approached the question of the patentability of a new combination of old elements "keeping in mind the very exacting standard long required by the Supreme Court" and in this connection it cited, among other decisions of this Court, *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147 (1950), and *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84 (1941). The Court of Appeals reviewed the prior art and found that nothing therein suggested the "unique combination of these

old features in such an assemblage as would solve the production, shipping, and operation problems which for years beset the insecticide industry as well as producers of other low viscous liquids." (R. 560.) It found that the novel combination of the sprayer with the insecticide container "which took years in the discovery is neither taught by, nor readily discernible from the application of mechanical skill to the elements of the prior art." It concluded that the patent met "the exacting standard required for a combination of old elements to rise to the level of patentable invention * * *." (R. 560, 561.)

Both the courts below found that the Calmar SS-40 shipper-sprayer infringed the Scoggin patent. Petitioners have not asked this Court to review the decision below on this point. Hence in this Court it must be taken as established that Calmar's SS-40 infringes the Scoggin patent.*

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*Although petitioners have not tendered the issue of infringement to this Court they nonetheless state in their section entitled "Statement of Facts" that "it was only through an extravagant application of the 'doctrine of equivalents' of *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 339 U.S. 605 (1950), that the courts below found infringement." (Pet. Br. p. 10, n. 12.) This statement is utterly without foundation in the record. The Court of Appeals held that "the challenged features of the alleged infringing Calmar SS-40, the combination of collar to cap seal with attendant hold-down of the sprayer head, are identical with respect to the sealing zone, principle, and purpose of Cook-Bakan 2 and differs only in the shape or form of the * * * sealing surfaces at the collar to cap engagement." The Court of Appeals agreed with the District Court that this difference is "uncontrolling." The Court of Appeals went on to state that "the practical effect of the accused device was to perform substantially the same function in substantially the same manner to obtain the same result as the patent in issue." (R. 562.) Notwithstanding Calmar's efforts to develop evidence of noninfringement the findings of the courts below on the question of infringement have abundant record support.

SUMMARY OF ARGUMENT

I. Both courts below gave full consideration to the conditions for patentability prescribed by §§ 101-103 of the Patent Act of 1952. The Court of Appeals, after its own analysis, correctly held that the evidence supports the District Court's findings that the Scoggin invention was a new, useful and non-obvious combination.

Under the concurrent findings below, the Scoggin invention is correctly defined as a novel combination of elements operating in conjunction to provide the new and useful result of presenting, for the first time, a shipper sprayer; that is, a sprayer which is integrated with a liquid container to solve both breakage and leakage problems. Such elements, though each individually old, are incapable, in performing their separate functions, of solving the problem or accomplishing the new result outside the combination.

Petitioners' attack on the finding of a novel combination avoids the issue in that it is directed essentially to the uncontested fact that each of the elements of the combination was individually old. Petitioners do not seriously dispute nor in any way convincingly demonstrate any error in the concurrent holding that *the combination* was new. Moreover, the record is replete with Calmar's own acts and statements in direct conflict with any contention that might be made denying novelty in the combination. And, petitioners make no showing of error in the findings below that the prior patents failed to teach or suggest the long awaited answer to the problem which Calmar tried so long to solve.

The holding of the courts below that the invention was useful is supported by evidence that for years the industry

had been searching for a shipper-sprayer and that the Scoggin invention was immediately accepted by the industry as satisfying that need by solving leakage and breakage problems.

There is also abundant evidence to support the holding of the courts below that the Scoggin invention was not obvious to a person possessing ordinary skill in the art. Calmar, the leading manufacturer of sprayers, had tried for ten years, with technicians whom Calmar itself described as "clever", without success to develop a shipper-sprayer. The only result of these efforts was the development of the shipper-sprayer which both courts below held infringed the Scoggin patent.

In short, the evidence fully supports the holding below that the patent covers a "unique combination" which "meets the exacting standard required for a combination of old elements to rise to the level of patentable invention."

II. The evidence of commercial success was relevant to, and was properly considered by the courts below as bearing primarily upon, the contested issue of utility of the invention and only secondarily upon its novelty and non-obviousness. Both the District Court and the Court of Appeals appreciated the limitations of this evidence in dealing with the basic question of patentability and it is plain from their opinions that neither court attached controlling importance to the commercial success of the Scoggin invention. The District Court said that the evidence was not "necessarily determinative" of the issue of invention and the court below merely treated the evidence as corroborative, saying that it "confirms our belief invention was produced."

III. Petitioners' assertion that the decision of the court below is "a debasement of the constitutional stand-

ard of invention" rests upon a general attack on the administration and procedures of the Patent Office and on decisions of certain Courts of Appeal in cases involving other patents. These arguments are irrelevant. The issue here is the validity of the Scoggin patent, not the procedures and practices of the Patent Office and not the validity of other patents. Since the Scoggin patent meets the conditions of patentability described by the Patent Act of 1952 and those laid down by this Court, no constitutional issue is presented. The Petitioners' arguments are wholly unrelated to the particular facts of this case and are calculated to divert attention from the issues herein presented for review. The Court of Appeals for the Eighth Circuit, whose judgment is here under review, has for many years strictly and severely applied the legal standard established by this Court for determining the validity of patents.

ARGUMENT

I. The Courts Below Correctly Held That the Invention Met the Requirements for Patentability Established by Congress

Sections 101-103 of the 1952 Patent Act (35 U.S.C. §§ 101-103) establish the requirements for the award of patents to inventors. Section 101 requires that the invention be new and useful. Section 102, insofar as relevant to this case, particularizes the requirement of novelty by requiring that the invention not have been described in a patent granted on an application filed before the invention in question was made. Section 103 provides that a patent shall not issue if the differences between the invention and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was

made to a person having ordinary skill in the art to which said subject matter pertains."

Both of the courts below considered the application of these requirements to the patent in issue and found that the requirements were met. A consideration of the record requires the conclusion that the courts below were correct.

A. The Patent in Question Covered a Novel Combination of Known Elements.

The description of the Scoggin patent at pages 8 and 11-15, *supra*, shows that the invention claimed in the patent consisted of a combination of several known elements. Petitioners have attempted in their brief to obscure this fact by selecting certain characteristics or aspects of the combination and arguing that those aspects, considered individually, must be the invention and as such are not patentable. For example, petitioners seek to convey the impression that respondent claims that the location of the seal within the overcap is the invention (Pet. Br. pp. 10, n. 12, 11, 19, 22) or that the space between the overcap and the container cap is the invention (Pet. Br. p. 5) and argue that these things are not patentable. These arguments are directed to a spurious issue. Respondent has never contended that the invention consisted of any one element, characteristic or aspect of the combination but in the combination as a whole. Both the District Court and the Court of Appeals dealt with the patent on this basis. Neither court sustained the validity of the patent on the ground that any one aspect or characteristic of the combination was a patentable invention.* The invention is concisely defined

*Petitioners suggest in their statement of the question presented that the invention covered by the Scoggin patent was the type of seal formed by the junction of the overcap and the threaded collar. (Pet. Br. p. 2.) As we have shown above, this is a misstatement of the issue that this court is called upon to decide.

by the Court of Appeals in the summation as *"a completely integrated device"* (R. 558) in the nature of *"a container with an integrated sprayer-pump"* (R. 557), the "novel 'marriage' of the sprayer with the insecticide container" constituting a "unique combination" (R. 560). (Emphasis ours.)

The District Court similarly held that the claimed invention related to a combination which it described at the outset of its opinion in these words:

> "The patent involves a pump spray device designed to be inserted into bottles or other containers for the dispensing of liquid contained therein. The particular device with which we are concerned here, is a screw cap designed to hold down the plunger of said spray pump when it is inserted in a bottle so as to prevent leakage and breakage while being shipped from processor, or while on the shelves of stores where such commodities are offered for sale." (R. 18.)

And in its discussion of the legality of the patent, the District Court specifically rejected petitioners' suggestion that the claimed invention related simply to the space between the overcap and the container cap and emphasized again that the invention consisted of a combination.

For many years insecticide manufacturers had sought such a combination, that is, a shipper-sprayer that could be inserted in the insecticide container at the time of bottling and shipped and sold as an integrated unit without exterior leakage of the liquid contents of the container or breakage of the sprayer. Until Scoggin's invention, no one had been able to satisfy this demand. Hence, for the most part, insecticide manufacturers were forced to market their products with a sprayer hung on the side of the insecticide container, a technique that had the substantial disadvantages described above.

Scoggin's invention was the breakthrough that permitted insecticide manufacturers successfully to integrate a sprayer with the insecticide container. It could hardly be denied that this was new. No other sprayer on the market at that time, and none marketed at any earlier time, was able to perform the function performed by the Bakan 2 shipper-sprayer. Hence, by any sensible interpretation of the term, Scoggin's invention was novel. Persuasive evidence of its novelty was supplied by petitioner Calmar whose president in November, 1958, in reporting to his department heads on the development of the infringing device referred to "the new SS-40 sprayers" (R. 544) and stated that "everything about the product is new" (R. 545).*

And the application for a patent on this infringing device included a claim that sought patent protection on the identical invention here in issue (R. 283), which was an admission that the invention was deemed to be novel. Obviously such claim could never have been allowed over the Scoggin patent.

It is true, as the courts below recognized, that no single element in the Bakan 2 shipper-sprayer was novel *per se*. But the fact that Scoggin's invention constituted a combination of known elements does not negate its novelty. *Bates* v. *Coe,* 98 U.S. 31, 48 (1878). See also *Hailes* v. *Van Wormer,* 87 U.S. (20 Wall.) 353 (1873); *Parks* v. *Booth,* 102 U.S. 96 (1880); *Loom Co.* v. *Higgins,* 105 U.S. 580 (1881); *Keystone Mfg. Co.* v. *Adams,* 151 U.S. 139 (1894); *Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.,* 220 U.S. 428 (1911).

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*At the same time the President of Calmar, who is also Vice-President of Drackett, said in describing the "new" sprayers:

> "To be sure the built-in seals described above plus a seal at the over-cap-collar junction are all new. * * * Actually, it is the largest new product project in Calmar's history." (R. 545.)

None of the prior art patents disclosed the shipper-sprayer invented by Scoggin. The Lohse patent did not disclose the idea of a seal above the threads inside the cover cap. In the Lohse patent the seal is formed with a gasket of some substance, apparently leather, which rests on the upper surface of the container cap (R. 26). Sealing on the upper surface of the container cap was not effective in preventing leakage (R. 150, 270-272). This form of seal was not efficient. The record fully supports the trial court's findings that the Lohse patent "would not solve the problem of leakage" (R. 26). And Drackett, Calmar's parent, did not itself consider Lohse as an anticipation—it knew of and specifically referred to the Lohse patent in its patent application on the infringing device.*

The Livingstone patent did not disclose the idea of an overcap that would depress the head of a sprayer; indeed, the Livingstone patent had nothing to do with a sprayer but related to a pouring spout.** (R. 385.)

The Mellon patent (R. 410) did not disclose the idea of a seal formed by the junction of a shoulder in the overcap with a rib on a threaded collar. The seal disclosed in Mellon is located on the upper edge of the bottle neck and was designed to prevent leakage at that point. Mellon does not utilize two caps; indeed, his seal is not unlike that of any conventional container cap. Moreover, the design of Mellon's device precludes establishment of a seal prior to

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*As we have pointed out above, Drackett's patent application included a claim that sought protection on the identical invention here in issue.

**Here, as in both courts below, petitioners make a point that Livingstone was not cited by the Patent Office. The feature of the particular type of seal which is illustrated (out of context) by petitioners at page 8 of their brief, from Livingstone, is better revealed by the Darley patent (R. 468) which was cited by the Patent Office. In view of this, the fact that the Patent Office did not cite Livingstone is wholly without significance.

its insertion in the container. One major feature of Scoggin's invention is its ability to be installed in the container without disturbing the overcap, thereby permitting maintenance of the seal that prevents leakage to the outside of the container.

In short, while each of the prior patents relied on by petitioners discloses some of the elements of respondent's combination, none discloses all of the elements in combination as invented by Scoggin. Scoggin's combination of the known elements in the form disclosed by his patent was the inventive act that justified the issuance of the patent. That was the basis of the decision of the court below which specifically found that the patent covers a "unique combination" that "meets the exacting standard required for a combination of old elements to rise to the level of patentable invention by fulfilling the long felt need with an economical, efficient, utilitarian apparatus which achieved novel results * * *." (R. 561.)

Petitioners make a frontal assault on this finding and assert that "the Scoggin patent did not even introduce a really new combination of elements" (Pet. Br., p. 22). They attempt to support this assertion by reliance on language extracted from the opinions of this Court in cases dealing with other devices not similar to the Scoggin invention, including among others *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U.S. 545 (1938); *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147 (1950); *Toledo Pressed Steel Co.* v. *Standard Parts, Inc.*, 307 U.S. 350 (1939); and *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84 (1941).

The court below did not disregard the teaching of these decisions. It cited these cases and recognized them as laying down "the exacting standard" that the patent in issue

required meeting. Its finding that the Scoggin patent meets that "exacting standard" is fully supported by the record and in no degree is inconsistent with the general principles previously announced by this Court.

Petitioners' attack on the finding rests upon a misapplication of the language of this Court to the facts of the present case. The statements quoted by petitioners cannot reasonably be read as meaning that in a combination patent each old element considered separately must perform some function in the combination different from the function it would perform as a separate device. Any such reading of the language would mean that no combination patent could ever meet the test of novelty. This Court has never laid down any such principle of law. The opinion in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp., supra* at 150-151, indicates that it had no intention of doing so.*

We submit that the opinions of this Court should be read as meaning that a combination of old elements may be patentable if the joint operation of the old elements in the combination performs or produces a new or different function or operation than was performed by any of the

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*If the prior statements of the Court could be read as laying down a general rule that no combination of old elements could be patentable, the question might arise whether any such rule of law could survive the passage of the Patent Act of 1952. The requirements for patentability set forth in Sections 101-103 of the statute do not draw any distinction between patents covering exclusively combinations of old elements and other patents. These provisions clearly indicate that a combination of old elements is patentable if it is novel, useful and the subject matter is not obvious. We believe, therefore, that it is unnecessary to consider in this case the question referred to above because this Court has never laid down any rule of law that a combination of old elements is not patentable.

parts separately.* This is the plain meaning of this Court's statement in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp., supra* at 151, that:

> "The negative rule accrued from many litigations was condensed about as precisely as the subject permits in Lincoln Engineering Co. v. Stewart-Warner Corp., 303 U.S. 545, 549: 'The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention.'"

On this basis the Scoggin patent clearly meets the standard laid down by this Court. The old elements in the combination perform in conjunction a function different from and greater than the functions they performed in the separate identities. Here the combination of the overcap, the threaded collar, and the seal above the collar threads formed by the junction of the overcap shoulder and collar rib with the sprayer and container cap permits for the first time integration of the composite unit with the container. This result which was obtained by the combination invented by Scoggin manifestly could not be obtained through the separate use of the individual elements of Scoggin's invention. In short, this is a case in which the combination of the old elements performs or produces a "new or different function or operation than that theretofore performed or

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*Respondent has never contended, as petitioners appear to suggest, that a combination of old elements is patentable merely because it is new and useful. (Pet. Br. pp. 24-25.) The invention must also meet the test laid down in Section 103 of the Patent Act of 1952, i.e., that the subject matter of the invention would not have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. The language quoted by petitioners from *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84, 90 (pp. 24-25 of their brief) is directed to this point and not to the question of novelty. The application of the standard prescribed in Section 103 to the Scoggin patent is discussed at pages 31-35 *infra*.

produced by them," *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U.S. 545, 549; the conjunction on concert of known elements contributes "something" which "exceeds the sum of its parts," *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, 152; and the old elements perform a joint function, they do not merely "serve separately" as they would individually, *Toledo Pressed Steel Co.* v. *Standard Parts, Inc.*, 307 U.S. 350.

B. The Shipper-Sprayer in Issue Clearly Had Significant Commercial Utility.

The record fully supports the findings below that the shipper-sprayer discovered by Scoggin was "useful" within the meaning of Section 101 of the Patent Act of 1952 and hence met that requirement of patentability.

For many years insecticide manufacturers had been subject to a pressing need for a sprayer that could be integrated into an insecticide container. The old method, by which the sprayer was attached to the container by means of a plastic or cardboard holder, had many drawbacks. As we have explained at pages 4-7, *supra*, it invited loss or pilferage of the sprayer, it resulted in breakage of the sprayer in shipment, it was uneconomical to assemble at the bottling plant, and it created problems of loss, damage, and special handling for the retailer. Because of the expanding availability of aerosol containers to package insecticides, sellers of liquid insecticides were at a competitive disadvantage as long as they remained unable to market their products with an integrated sprayer system. Various alternative devices which Calmar had attempted to develop had proved unsuccessful.

Respondent's shipper-sprayer was designed to and did solve the problems presented by the old method of hanging

the sprayer on the liquid container, thereby eliminating the commercial advantage held by sellers of insecticides that were marketed in aerosol containers. The utility of the invention was demonstrated by the immediate efforts of petitioner Calmar to copy it, notwithstanding the fact that Calmar had only shortly before introduced a bayonet type of sprayer (the S-25-LP) on the market.* It was also demonstrated by the fact that in the first twelve months that the Scoggin invention was on the market 11,000,000 of them were sold.

Petitioners advance no basis that would justify the rejection of the finding of the lower courts on the issue of usefulness. They have attempted to revive in this Court their argument that the Scoggin patent did not completely solve the problem of leakage. This is a pure issue of fact which was resolved against petitioners by the trial court in findings that were affirmed by the court below. The record fully supports those findings. The best that can be said for petitioners' contention, which is based upon meager evidence, that the Scoggin invention did not provide a "perfect seal" (Pet. Br., pp. 8, 23, n. 30) is that it rests upon an alleged conflict in the evidence. That conflict, if it exists, provides no justification for trial of the issue *de novo* in this Court.**

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*Calmar's S-25-LP sprayer was utterly unsuccessful in solving the problems to which Scoggin's invention was directed. Calmar's president testified that his company experienced "grievous" results with the sprayer, and finally withdrew it from the market.

**Among other things, the trial court found that with respect to 15,000,000 of the Scoggin shipper-sprayers that Cook had used on its products and sold to consumers it received not more than 100 complaints.

This Court has held that the fact that a patented device may in some instances be imperfect in its operation is not a reason for invalidating the patent if the device otherwise meets the standards of patentability. *Telephone Cases*, 126 U.S. 1, 535 (1888); *Mergenthaler Linotype Co.* v. *Press Publishing Co.*, 57 Fed. 502, 505 (C.C. S.D. N.Y. 1893); *Hildreth* v. *Mastoras*, 257 U.S. 27, 34 (1921).

It is significant that most of the petitioners' discussion of the question of usefulness is not directed to demonstrating that the courts below were wrong in finding that the Scoggin shipper-sprayer was useful but rather to the assertion that the courts attached excessive importance to its commercial success. We shall show at pages 35-38, *infra*, that the decisions below did not turn on the commercial success of the invention. For present purposes it is enough to observe that commercial success is clearly relevant on the issue of the usefulness of the invention and that the kind of proof of commercial success that was made in this case is sufficient to demonstrate that the invention met that particular requirement.

C. Respondent's Invention Was Not Obvious to a Person Having Ordinary Skill in the Art.

Section 103 of the Patent Act of 1952 provides in substance that a patent may not be obtained if the differences between the subject matter of the invention and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertained. This statutory provision embodies a condition of patentability that has been expressed in one way or another in decisions of this Court since as early as *Hotchkiss* v. *Greenwood*, 52 U.S. (11 How.) 248 (1850). See also *Pearce* v. *Mulford*, 102 U.S. 112, 118 (1880).

Petitioners argue that the Scoggin patent does not meet the condition of patentability now set forth in Section 103 and in support of this argument cite decisions, notably *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84, in which this Court has reversed decisions upholding the validity of patents on the ground that the lower court had failed to recognize that "to obtain the privileged position

of a patent more ingenuity must be involved than the work of a mechanic skilled in the art" (Ibid. at 90). Petitioners assert that the lower courts in this case committed the same error (Pet. Br. 20, 21, 23-25).

Petitioners' contention that the decisions below disregarded and failed to apply the condition of patentability set out in Section 103 is plainly erroneous. Both the District Court and the Court of Appeals recognized and applied the correct rule of law. The Court of Appeals stated:

> "This novel 'marriage' of the sprayer with the insecticide container which took years in the discovery is neither taught by, nor readily discernible from the application of mechanical skill to the elements of the prior art."* (R. 560.)

The question presented, therefore, is not whether the courts below applied an erroneous legal standard but whether the findings of fact made by the District Court and affirmed by the Court of Appeals are supported by the record. Petitioners' arguments on that question consist largely of assertions which are unsupported by the record and which are destroyed by undisputed evidence with respect to the activities of Calmar itself.

The record shows that Calmar for a period of ten years devoted time, money and effort in an attempt to solve the very problem that remained unsolved until Scoggin's invention was made. These labors were more than intermittent. The record shows that Calmar experimented with a variety of different devices in an unsuccessful effort to solve the problem of creating a shipper-sprayer that could be incorporated with liquid containers. To name a few of

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*The District Court set forth the text of Section 103 and then stated that under that section the question was whether the combination covered by the Scoggin patent was "merely the result of mechanical skill." The court discussed this question in the ensuing three paragraphs of its opinion and found that the patent met the conditions of Section 103 (R. 25).

these devices, Calmar's technicians tried (1) a cellulose cover to be installed over the top of the sprayer to seal it, (2) a form of bayonet type device—the S-25-LP, (3) a flat back bottle that could be shipped on its back in order to avoid leakage, (4) an installation of a film bag (or boot) around the lower portion of the sprayer, (5) a cap for installation over the nozzle of the sprayer, (6) a plug to be installed in the end of the sprayer tube. All of these efforts came to nothing. Not one resulted in a product that would permit the integration of a shipper-sprayer with a container without leakage of the liquid or breakage of the sprayer. It was not until Calmar produced a copy* of the Scoggin invention that it had the answer to the problem with which its technicians had wrestled for ten years.

The Court of Appeals concluded its review of what it called the "undisputed factual background" (R. 556) with these words:

> "Despite the extensive research and experimentation given the problem by Calmar, Cook and others for a period of some ten years, no solution was forthcoming until conception and commercialization of the Cook-Bakan 2, described by its inventor as a 'Pump-Type Liquid Sprayer Having Hold-Down Cap.'" (R. 557.)

In these circumstances one of two conclusions must be true. Either the technicians employed by Calmar to solve the problem did not possess ordinary skill in the art or the subject matter of the Scoggin patent was not obvious

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*The lower courts' determination of infringement is not here contested. The Court of Appeals said that:

> "Exercising our appellate prerogative in a patent case to interpret the exhibits for ourselves, we are constrained to agree with the trial court's statement that 'Upon close inspection of the devices, it is difficult to see how they could be much more similar and yet have any different features'." (R. 562.)

at the time the invention was made to persons possessing such skill. For good reason petitioners have not embraced the first of these alternatives. Nothing in the record provides the slightest support for any suggestion that the technicians employed by Calmar were not skilled in the art. The president of Calmar himself testified that the company had "for a good many years a number of good, clever people" engaged in research efforts (R. 306). These persons included Andrew M. Martin, who in 1944 had obtained two patents relating to the original plastic sprayer (R. 334), and Rex C. Cooprider, who with D. F. Corsette applied for the patent (R. 529) on the device held by the courts below to have infringed the Scoggin patent. Corsette, who held Bachelor's and Master's degrees in engineering, and who had formerly been in the employ of a company engaged in the construction of automatic assembly machines for sprayer devices, was brought in to Calmar as "a skilled, capable engineer, because we were faced with real problems with our own customers, our own products * * *" (R. 306) after the efforts of its research staff had failed to produce a shipper-sprayer.

Against these facts, the *ex post facto* and *post litem* assertions of Calmar that the Scoggin invention was obvious are entitled to no weight whatever. This Court has often held that the fact that an invention when viewed after the event is asserted to be, or may even appear to be, obvious is not enough to negative patentability. *Goodyear Tire & Rubber Co., Inc.* v. *Ray-O-Vac Co.*, 321 U.S. 275, 279 (1944); *Loom Co.* v. *Higgins*, 105 U.S. 580, 589, 591; *The Barbed Wire Patent*, 143 U.S. 275, 277, 283 (1892); *Krementz* v. *S. Cottle Co.*, 148 U.S. 556 (1893); *Expanded Metal Co.* v. *Bradford*, 214 U.S. 366, 381 (1909); *Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.*, 220 U.S. 428, 434-435.

We submit that there could be no stronger proof that the Scoggin invention was not obvious than this showing that the major company producing plastic sprayers, employing technicians possessing extraordinary skill in the art, was unable to solve the problem despite continuous efforts over a ten-year period to do so. Precisely that showing was made in this case. That showing distinguishes this case from the prior decisions of this Court cited by petitoners and establishes that the Scoggin patent satisfied the requirements set forth in Section 103 and the standards set forth in the decisions of this Court. This case is governed by the rule stated in *Expanded Metal Co.* v. *Bradford, supra* at 381:

> "It may be safely said that if those skilled in the mechanical arts are working in a given field and have failed after repeated efforts to discover a certain new and useful improvement, that he who first makes the discovery has done more than make the obvious improvement which would suggest itself to a mechanic skilled in the art, and is entitled to protection as an inventor."

See also *Goodyear Tire & Rubber Co., Inc.* v. *Ray-O-Vac Co., supra.*

II. The Decisions Below Do Not Substitute "Commercial Success for Invention."

The petitioners contend that "it is impossible to find any real basis for the decision below other than the 'commercial success' of respondent's sprayer" and that the courts below, therefore, erroneously substituted the concept of commercial success for the concept of invention (Pet. Br. p. 27). In support of this argument petitioners cite decisions of this Court for the proposition that commercial success alone is not determinative of the question of patentability. This general proposition is not in dispute and it is there-

fore unnecessary to discuss the decisions that petitioners say establish it. The fact is that an analysis of the decisions of the courts below—which petitioners notably failed to undertake—shows that those decisions did not rest on that ground primarily or ignore the proper requirements of patentability.

The opinion of the Court of Appeals begins its consideration of the validity of the patent by recognizing the "exacting standard" that this Court has laid down for determining the patentability of a combination of old elements. It then proceeded to consider the prior art—contrary to petitioners' assertion that it did not do so (Pet. Br. p. 29, n. 37)—and then moved on to consider whether the subject matter of the Scoggin patent was "readily discernible from the application of mechanical skill to the elements of the prior art." It was only after finding that it was not so discernible that the Court of Appeals mentioned the matter of commercial success. It is significant that the reference to commercial success was made in the context of the issue whether the device produced "new and useful results." It is also significant that the Court of Appeals, in referring to the evidence of industry and public acceptance, stated that it "confirms our belief that invention was produced," thereby indicating that the evidence was regarded simply as corroboration of a finding made primarily on other grounds.

Proof of commercial success is clearly relevant to the question whether a device is new and useful. *Temco Elec. Motor Co.* v. *Apco Mfg. Co.*, 275 U.S. 319 (1928); *Forestek Plating & Mfg. Co.* v. *Knapp-Monarch Co.*, 106 F.2d 554 (6th Cir. 1939); *Ezee Stone Cutter Mfg. Co.* v. *Southwest Industrial Products*, 262 F.2d 183 (8th Cir. 1958); *Reiner* v. *I. Leon Co.*, 285 F.2d 501, 503 (2d Cir. 1960). The fact that the Court of Appeals properly considered the evidence of

commercial success for that purpose does not demonstrate that its decision rested primarily on that consideration.

The opinion of the District Court shows affirmatively that it recognized that commercial success is not controlling on the issue of patentability. That court, although referring to the evidence relating to commercial success in its detailed statement of facts developed at the trial, made only one reference to commercial success in its discussion of the legal issues. In the course of this discussion it said:

> "Commercial success or acceptance is an element that may be taken into consideration in determining the question of invention, but is not necessarily determinative of the issue." (R. 28.)

There is no rational basis on which the court's explicit statement that evidence of commercial success is "not necessarily determinative of the issue" can be twisted into meaning that it regarded that evidence as decisive and controlling.

A reading of the opinion of the District Court as a whole shows it did not rely exclusively, primarily, or even substantially on evidence relating to commercial success. Its finding that the subject matter of the Scoggin patent was new and useful and not obvious to a person having ordinary skill in the art rested on facts of a different character. It relied, for example, upon evidence that for years manufacturers of insecticides and of sprayers for liquid containers had tried unsuccessfully to solve the problem of leakage and breakage in shipment; that specifically Calmar had attempted to solve this problem and had devised numerous contrivances that were unsuccessful; that the Scoggin invention successfully solved the problem of leakage and breakage in shipment, and that the solution achieved by Scoggin required more than the application of simple mechanical skill.

No doubt some of these facts are also relevant to the question of commercial success but the presence of commercial success is not a bar to patentability when the relevant statutory standards are otherwise satisfied. As Judge Learned Hand stated in *Reiner* v. *I. Leon Co., supra* at 503:

> "We are of course acutely aware of the constant reminders in the books that the sale of a patented device is not alone a measure of its invention, and we accept that conclusion. Nevertheless, great commercial success, *when properly scrutinized,* may be a telling circumstance." (Emphasis supplied.)

Petitioners themselves in the courts below squarely raised the issue of commercial success by contending that the Scoggin invention was not useful because it did not solve the problem of leakage and by devoting a substantial part of their evidence to that contention. In these circumstances, petitioners are hardly in a position now to contend that the courts below erred in considering the evidence of commercial success for the purpose of resolving the issue of utility and for whatever relevance it might otherwise have to the question of patentability. The courts below "properly scrutinized" this evidence. Their opinions show that they did not regard the evidence as controlling or decisive.

III. The Decision of the Court Below Did Not Countenance "A Debasement of the Constitutional Standard of Invention"

Petitioners devote the opening portion of their argument (Pet. Br. pp. 14-22) to the assertion that the decisions below countenance "a debasement of the constitutional standard of invention." To support this line of argument petitioners attack the administration and the procedures of the Patent Office (Pet. Br. pp. 14, 18-19); they attack

the decisions of other Circuit Courts of Appeal in cases involving other patents (Pet. Br. pp. 19-20); and, oddly enough, in view of their own economic position and power, they suggest by innuendo that this case raises some problem of restraint of trade or monopoly under the antitrust laws (Pet. Br. pp. 15, 30). When these assertions are viewed in the context of the issues presented here their irrelevance is obvious.

The issue in this case is the validity of a particular patent issued to Scoggin on January 27, 1959. We have shown in the preceding portions of our argument that the facts of record fully support the findings made by the District Court that the subject matter of the patent is new, useful and not obvious to one having ordinary skill in the art. In making these findings, the District Court applied the legal standards prescribed by Sections 101-103 of the Patent Act of 1952. In affirming these findings the Court of Appeals specifically recognized and applied what it described as the "exacting standard" laid down by this Court for determining the validity of combination patents. Since the courts below recognized and applied the correct rules of law, the only issue in this case is whether the findings of fact that the subject matter of the patent is new, useful and unobvious are supported by the record.

Petitioners have not suggested either here or in the courts below that the provisions of the Patent Act of 1952 are unconstitutional.* Since the courts below applied the provisions of that statute and in doing so complied with the principles of law laid down by this Court, this case raises no

*Petitioners appear to concede that at least the last sentence of Section 103 of the Patent Act of 1952 was meant to correct what petitioners describe as "an extravagant interpretation" of certain language in the opinion of this Court in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 89 (Pet. Br. p. 21, n. 19). Petitioners do not suggest that when Congress made this correction it exceeded its constitutional powers.

question of constitutional law but turns simply on the question of whether the findings of fact made by the District Court and affirmed by the Court of Appeals are supported by the record.

In short, what is involved here is the validity of the particular patent in issue, not the administration and procedures of the Patent Office considered in gross and not whether other Circuit Courts of Appeal have improperly held other patents to be valid. No extensive analysis is required to show the logical irrelevance of petitioners' assertion with respect to these extraneous matters.

The fact that the Patent Office issued approximately 50,000 patents in 1959 has no logical bearing on the question whether any particular patent issued in that year is invalid. There is no doctrine in law or logic of invalidity by statistical association.

The assertion, if true, that other Circuit Courts of Appeal have erroneously upheld the validity of other patents is likewise irrelevant. Petitioners seem to believe that it would be proper for this Court to invalidate the Scoggin patent as a means of disciplining and admonishing other Circuit Courts of Appeal for departing from correct legal principles. This is a curious view of the nature of judicial process. We assume with confidence that, even if this Court should agree with petitioners that in other cases involving other patents and other facts, some of the Courts of Appeal may have erroneously upheld the validity of those patents, it will not allow that view to influence the decision herein in any way whatever.

Even if it is assumed that it would be proper for this Court in this case to consider whether some of the Circuit Courts of Appeal stand in need of admonition and discipline, we think it appropriate to observe that the Court of Appeals

for the Eighth Circuit is not among them. It is significant that in the parade of horribles set out by petitioners at pages 19 and 20 of their brief, they have not cited a single decision by the Court of Appeals for the Eighth Circuit. The fact is that the record of that court in dealing with patent cases shows that it has not been lax or lenient in applying the legal standards announced by this Court.

In the ten years, 1949 through 1958, the Court of Appeals for the Eighth Circuit held 23 patents invalid and only 3 patents valid and infringed. The ratio of the decisions in the Eighth Circuit is thus nearly eight to one against validity. The overall ratio for all Circuit Courts of Appeal in the same period is nearly three to one against validity.* Since 1958 the Court of Appeals for the Eighth Circuit has held eleven patents invalid for lack of invention, including the patent which is now before this Court in *Graham* v. *John Deere Co.*, No. 11, October Term, 1965.** In the same period of time, apart from the instant case, the

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*An Analysis of Patent Litigation Statistics, Staff Report, Subcommittee on Patents, Trademarks and Copyrights, Senate Judiciary Committee, 86th Congress, 2nd Sess., 1961.

**_Johnson Fare Box Co._ v. _National Rejectors, Inc._, 269 F.2d 348 (8th Cir. 1959).

Caldwell v. _Kirk Mfg. Co._, 269 F.2d 506 (8th Cir. 1959).

John Blue Co. v. _Dempster Mill Mfg. Co._, 275 F.2d 668 (8th Cir. 1960).

Selmix Dispensers, Inc. v. _Multiplex Faucet Co._, 277 F.2d 884 (8th Cir. 1960).

Syracuse v. _H. Daust Mfg. Co._, 280 F.2d 377 (8th Cir. 1960).

Scherr v. _National Bio-Test, Inc._, 301 F.2d 901 (8th Cir. 1962).

McGraw-Edison Co. v. _Central Transformer Corp._, 308 F.2d 70 (8th Cir. 1962).

Collins v. _Owen_, 310 F.2d 884 (8th Cir. 1962).

Rota-Carb Corp. v. _Frye Mfg. Co._, 313 F.2d 443 (8th Cir. 1963).

Bros Inc. v. _Browning Mfg. Co._, 317 F.2d 413 (8th Cir. 1963).

John Deere Co. of Kansas City v. _Graham_, 333 F.2d 529 (8th Cir. 1964).

Court of Appeals has sustained the validity of only two patents where invention was in issue.*

An examination of the opinions of the Court of Appeals for the Eighth Circuit shows that it has strictly enforced the requirements for patent validity laid down by this Court in such cases as *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84 (1941) and *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147 (1950). It is also to be noted that the Court of Appeals has not in any way modified or relaxed these requirements since the passage of the Patent Act of 1952. See *Steffan* v. *Weber Heating & Sheet Metal Co.*, 237 F.2d 601 (8th Cir. 1956) and *John Blue Co.* v. *Dempster Mill Mfg. Co.*, 275 F.2d 668 (8th Cir. 1960).**

Ezee Stone Cutter Mfg. Co. v. *Southwest Industrial Products*, 262 F.2d 183 (8th Cir. 1958).

Wm. F. Crome & Co. v. *Vendo Co.*, 299 F.2d 852 (8th Cir. 1962).

**In 1960 in the *John Blue* case, the Court of Appeals stated:

"In applying 35 U.S.C.A. § 103, this court follows the standards of patentability set out by the United States Supreme Court in Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 1950, 340 U.S. 147 * * *." (275 F.2d at 671.)

Many years ago the Court of Appeals employed language, similar to that used in 35 U.S.C. 103 of the Patent Act of 1952, which it adopted from *Pearce* v. *Mulford*, 102 U.S. 112, 118 (1880), wherein this Court said that an improvement:

"* * * must involve something more than what is obvious to persons skilled in the art to which it relates."

The court held the patent there under review invalid, stating:

"A patent must be the creation of inventive faculty and imagination. There must be something more than is obvious to persons skilled in the art. Mere novelty and utility is not invention, and cannot be a substitute therefor. Neither is ingenuity invention. A patent monopoly rests upon inventive genius and the line between invention and mechanical skill is ofttimes a close one, almost impossible to discern." *Tropic-Aire* v. *Sears, Roebuck & Co.*, 44 F.2d 580, 588 (8th Cir. 1930). See also, *H. D. Hudson Mfg. Co.* v. *Standard Oil Co.*, 60 F.2d 377 (8th Cir. 1932).

Petitioners' references to monopoly and restraint of trade are similarly irrelevant in the context of this case. In view of the size and economic power of petitioners it could hardly be suggested that validation of the Scoggin patent will in any way restrict their competitive capabilities. In these circumstances, no general discussion of the relationship between the patent laws and the prevention of monopoly or the preservation of free competition seems necessary or appropriate. It is appropriate to observe, however, that, as the facts of the instant case disclose, a patent is not invariably a device for increasing the concentration of economic power but may well serve as a shield for the small businessman against the economic power of his larger diversified and integrated competitors.* In this connection, it is difficult to avoid the impression that petitioners' references to the antitrust law as well as their attacks upon the Patent Office and the Circuit Courts of Appeal are an attempt to cloak in the aura of the public interest what is essentially a piece of deliberate commercial piracy.

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*See Dr. Vannevar Bush, Study No. 1, made pursuant to Senate Resolutions 92 and 167 of the 84th Cong., 2d Sess., 1956, p. 19; Briskin, *An Area of Confusion: Patents Monopolies and the Antitrust Laws*, 49 A.B.A.J. 661, 663 (1963); Malley, *Patent Antitrust Problems and the Attorney General's Report*, 24 Geo. Wash. L. Rev. 20, 25 (1955); Edwin H. Land, *The Role of Patents in the Growth of New Companies*, 41 J. Pat. Off. Soc'y 502, 506 (1959); George E. Frost, *The Role of the Law in Research Competition*, 3 P.T.C.J. Res. & Ed. 93, 95 (1959); and Irving H. Siegel, *Patents and Other Factors in the Creation and Growth of Small Firms: Preliminary Synthesis*, 3 P.T.C.J. Res. & Ed. 47 (1959) (Proceedings 1959 Annual Public Conference of the Patent, Trademark and Copyright Research Institute, George Washington University).

CONCLUSION

For the reasons stated above, the judgment of the Court of Appeals should be affirmed.

Respectfully submitted,

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APPENDIX

The relevant provisions of the Patent Act of 1952, 35 U.S.C. §§ 101, 102 and 103, are as follows:

§ 101. Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§ 102. Conditions for patentability: novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

§ 103. Conditions for patentability: non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the

subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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